

REMARKS

Claims 3, 18, 20, 21, 23, 24, 36-40, and 43-45 were pending. By this Amendment, new claims 46-62 are presented. The title is amended to reflect more accurately the claimed subject matter. The specification and claims are amended to correct minor typographical errors, to provide full names for various acronyms, and to change “(dex)pantenol” to “dexpanthenol.” No new matter is added.

Claim Rejections: 35 U.S.C. § 102

Claims 3, 18, 20, 24, 36-39, and 43-45 were rejected under 35 U.S.C. § 102(b) as reciting subject matter “clearly anticipated by Siccprotect™.” In rejecting the claims, the Examiner wrote on page 3 of the Action:

Siccprotect™ is disclosed as containing dexpanthenol and is used in eye drops compositions for contact lenses (see D1 -D4). The composition appears to also contain polyvinyl alcohol and benzalkonium chloride as a preservative used against gram-positive and gram-negative bacteria (see D1 and D2). The composition is clearly anticipated. The methods of disinfection, storing and cleaning contact lenses are therefore also clearly anticipated.

Applicant asks the Examiner to reconsider and withdraw this rejection because the cited references do not disclose the kits and methods of use recited in the pending claims. In particular, the references do not disclose the use of Siccprotect eye drops in impregnating, disinfecting, storing, and/or cleaning contact lenses.

As disclosed in references D1-D4, Siccprotect eye drops are a tear substitute (D1, section 3.1). The drops are an aqueous solution of dexpanthenol, polyvinyl alcohol, and benzalkonium chloride (D1, sections 3.2.1 and 3.2.2). The drops are applied directly to a person's eyes for the purpose of remoisturizing the eyes (D1, section 10: “Instill 1 drop in the conjunctival sac up to 6 times a day”).

Applicant does not dispute that the references disclose an eye-drop composition containing dexpanthenol, and Applicant is not claiming such a composition. Rather, Applicant invented novel kits and novel methods of using that composition to impregnate, disinfect, store, and/or clean contact lenses.

The Examiner takes the position that all claimed uses of the composition are “clearly anticipated” simply because the composition itself is disclosed. But the Examiner’s position is mistaken; it has been long established that the “invention of a new use of a known . . . composition of matter or material may be patentable.” *In re Hack*, 245 F.2d 246, 248 (C.C.P.A. 1957); M.P.E.P. § 2112.02 (citing *In re Hack*). Here, Applicant realized that dexpantenol, already known as an ingredient in eye drops, could also be adapted to the new uses of impregnating, disinfecting, cleaning, and storing contact lenses.

References D1-D4 never disclose or suggest that a dexpantenol-containing solution can be used for impregnating, disinfecting, storing, or cleaning contact lenses, or that it may be included in a kit with contact lenses. References D1-D4 disclose the use of the composition only as eye drops and for no other use. The Siccaprotect drops are directly applied to one’s eyes for the purpose of remoisturizing. The references do not disclose use of Siccaprotect drops outside the eye, nor do they disclose direct application on contact lenses. The Siccaprotect product thus has nothing to do with contact lens care. Although the references disclose use of the eye drops while hard contact lenses are being worn (D1, section 4), the instructions for use (D1, section 10) make clear that drops are still applied directly to the eyes for the purpose of moisturizing the eyes, not for impregnating, disinfecting, storing, or cleaning the contact lenses.

Indeed, use of Siccaprotect™ eye drops is contraindicated when wearing soft contact lenses because the benzalkonium chloride in the drops can accumulate in the soft lenses (D1, section 5; D3, last line of first page). Hence, the references not only fail to disclose but also expressly contradict the subject matter of claims 46, 53, 60, and 61.

Respectfully submitted,
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